Attorney Docket No.: KOP 2001-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: *Dunkeld et al*	) Art Unit: *3621*
Serial No.: *10/016,325*	) Examiner: *Augustin, Evens J*
Filed: 12/10/2001	)
For: *System & Method for Unique Digital Asset Identification and Transaction Management*	)

(SECOND REPLACEMENT) DECLARATION UNDER 37 C.F.R. 1.131

The undersigned, Bryan C. Dunkeld declares and states that,

1. I am one of the inventors of the above referenced application, which was filed on December 10, 2001. This declaration is submitted to show that we (the inventors) had conceived of the subject matter of the present claims prior to November 21, 2001 (the effective filing date of the O'Kane reference (US Publication No. 23097229)) and diligently reduced the same to practice.

Conception

2. That we had conceived of the subject matter of the present claims is evidenced by the Exhibits attached hereto. These exhibits document certain figures and other disclosure materials provided to and by our attorney, J. Nicholas Gross, prior to November 21, 2001.

3. To wit, Exhibit 1 is a copy of the figures given to Mr. Gross prior to such date. As the Examiner can verify, they show effectively the same architecture and operation as the final figures submitted with the present application. These figures show all elements of the independent claims pending in the present case. For example, for claim 22, the Examiner can see the following correlations to the figures:

22: A system for exchanging digital assets over a network, comprising:	See FIG. 1
(a) a first computer coupled to the network, said first computer storing a digital asset which includes both digital content and a first unique identifier associated with a first instantiation of said digital asset; and	FIG. 1 (Host server 110) and FIG. 2 (steps 210 – 216)
(b) a second computer coupled to the network; and	Customer network device 112
(c) a first software routine executing on said first computer and/or said second computer, said first software routine being adapted to coordinate transfer of said digital asset to said second computer;	See FIG. 1 and FIG. 3, step 322
wherein a second instantiation of said digital asset is created for said transfer to said second computer, said second instantiation including a second unique identifier.	See FIG. 3, step 316

4. A similar analysis can be seen to apply to claim 55 as well. In Exhibit 2 I have provided a true copy of a printout of the metadata for such document. The redacted date showing the creation date of such file is prior to November 21, 2001.

5. An initial specification was also prepared by Mr. Gross on our behalf prior to November 21, 2001, along with proposed claims. A copy of such claims is provided in Exhibit 3. The Examiner can see quite clearly that we had conceived of the subject matter of claim 22 (then claim 21) before the prior art filing date.

6. Again the claims shown in Exhibit 3 were provided in the form of a Microsoft WORD document. A true copy of the metadata for such claims file is shown in Exhibit 4, and I can affirm again that the redacted data showing the creation date of such file is prior to November 21, 2001.

Diligence

7. In addition to the fact that our inventions were conceived prior to November 21, 2001, I can also confirm that we diligently reduced such to practice (in the form of the present filing) beginning at a time prior to such reference. In particular, the materials shown in these exhibits were part of a draft application that was undergoing regular revisions both prior to and after such date. The materials were then embodied in the patent filing made on December 10, 2001 - less than 3 weeks after the filing date of the reference.

8. In particular, the figures shown in Exhibit 1 were contained in a Microsoft WORD document provided to Mr. Gross at least as early as November 2, 2001, which is when I first communicated such materials (along with the rest of the disclosure) to Mr. Gross so that he could prepare an application on our behalf. For evidence of this, please see Exhibit 5, which is my email to Mr. Gross communicating such materials. The substance of the communication is privileged so it has been redacted, but as you can see from the header it corroborates my statement that such materials were sent on such date.

9. Thus as early as November 2, 2001 we had provided Mr. Gross with an initial draft of the disclosure to craft into a formal application. In between such date and the actual filing date (December 10, 2001) the case was in Mr. Gross' hands, as he actively prepared the formal application. We exchanged another draft of the specification on November 19, 2001 – see Exhibit 6. Again the substance of the communication is privileged so it has been redacted, but as you can see from the header it corroborates my statement that such materials were sent on such date.

10. After delivering such second draft, the disclosure underwent further active and regular treatment to put it into appropriate form for filing. I communicated regularly with Mr. Gross between November 19 and December 10 (the filing date) to assist him, discuss changes to the disclosure, and ensure that the filing would be made on a timely basis. As seen in Exhibit 7, in this email Mr. Gross confirmed that was going to finalize the application during sometime during the week of December 4, and we made arrangements for the inventors to sign and return the appropriate oaths and powers of attorneys.

11. From my conversations with Mr. Gross it is my information and belief that he was working on such application as expediently as possible given his other backlog of cases at such time. In fact, it is my understanding and recollection that Mr. Gross adjusted his schedule to advance and perfect our application over other projects he had at such time. As I also understand it is typical that most patent attorneys will require several weeks if not months of time to convert a disclosure into a formal filing, yet Mr. Gross did it in just a few weeks to handle our case. Thus in addition to my efforts I submit Mr. Gross was also working extremely diligently on our behalf to reduce the inventions to practice in the form of the present filing.

12. All statements made of my own knowledge are true and all statements made on information and belief are believed to be true; I further acknowledge that wilfull false statements are punishable by fine or imprisonment, or both, under Section 1001 of Title 18, and that such may also jeopardize the validity or enforceability of the application and/or any patent issued therefrom.

Executed in Edmonds, Washington on July 3 2008.

Bryan C. Dunkeld

Bryan C. Dunkeld

EXHIBIT 1 - FIGURES FOR SN 10/016/325
PRIOR TO NOVEMBER 21, 2001

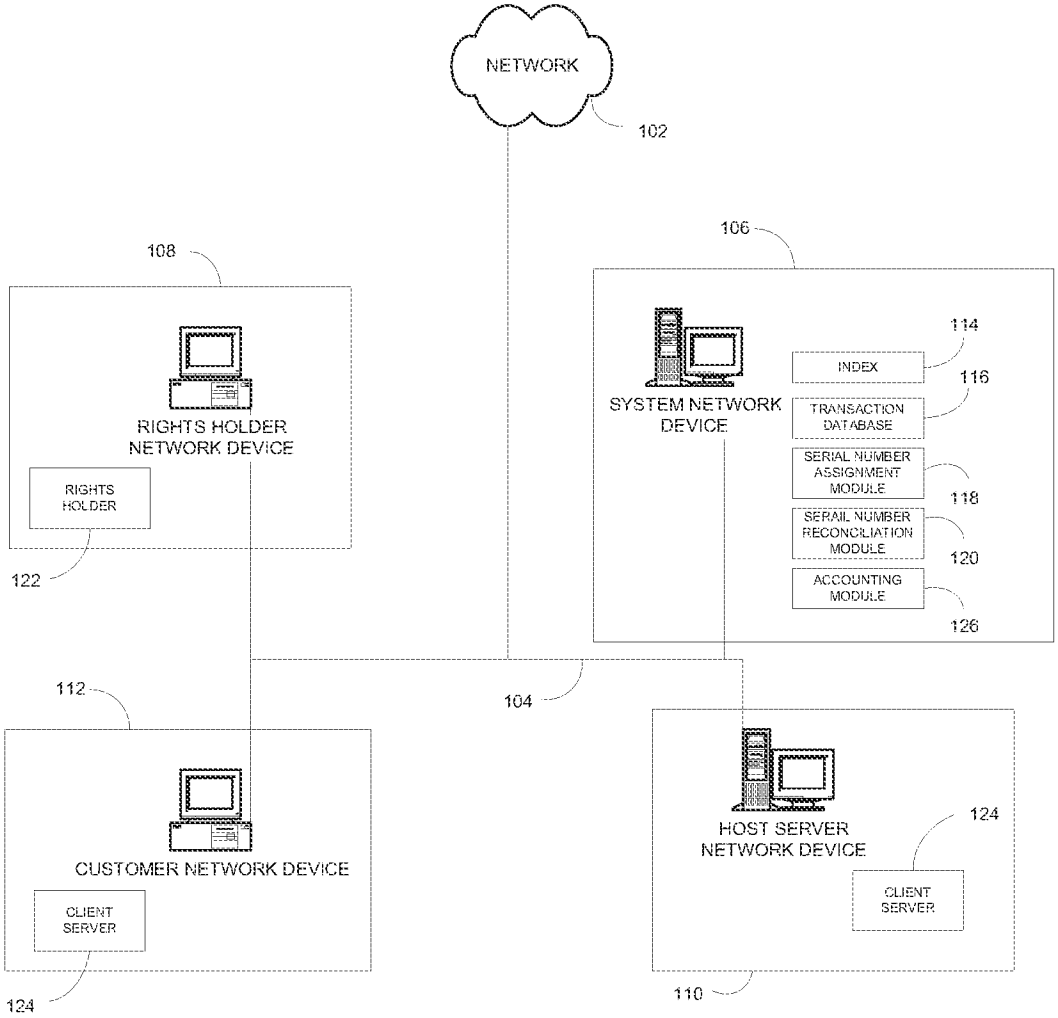

FIG. 1

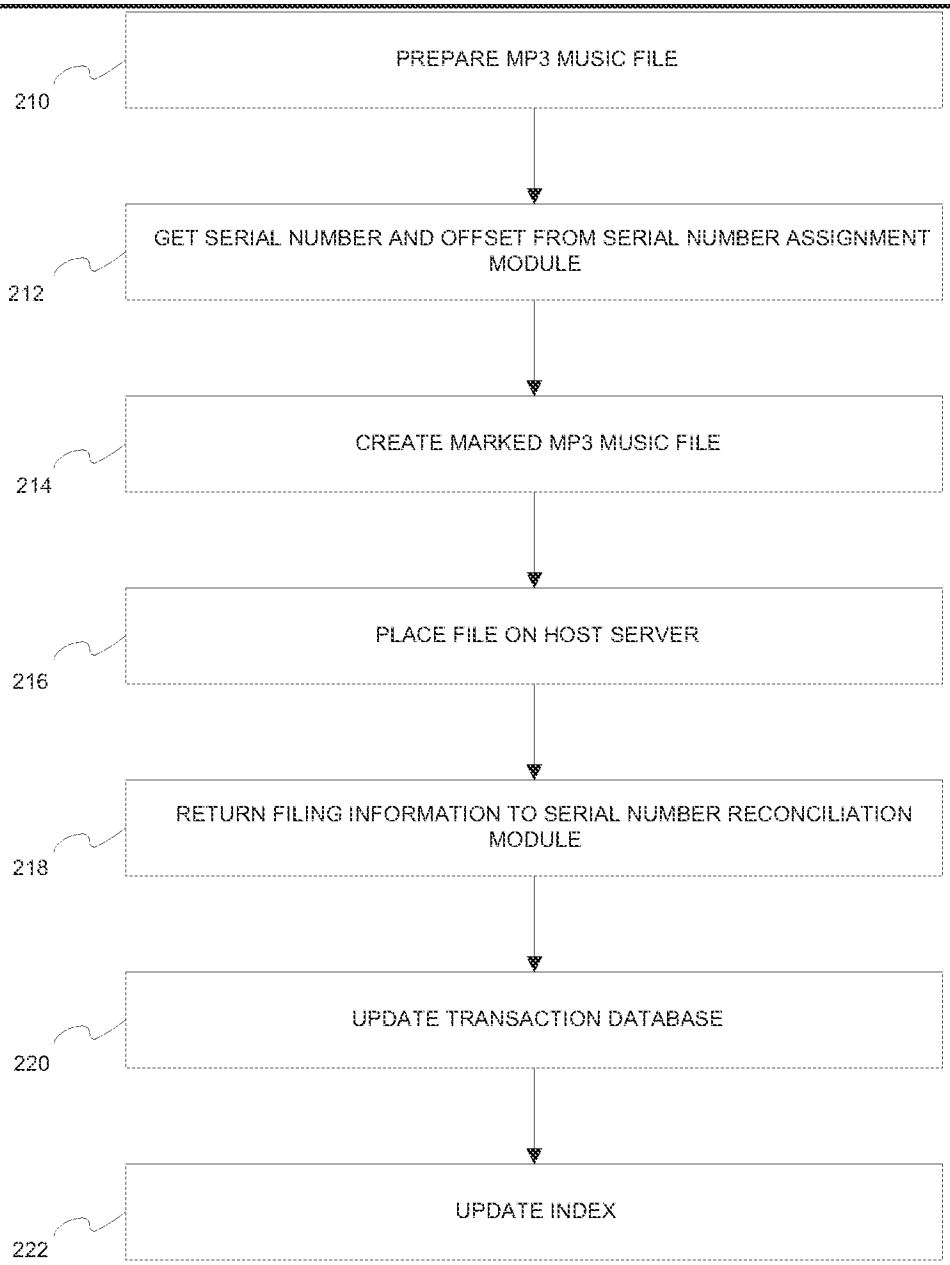
PREPARE MP3 MUSIC FILE
210
GET SERIAL NUMBER AND OFFSET FROM SERIAL NUMBER ASSIGNMENT MODULE
212
CREATE MARKED MP3 MUSIC FILE
214
PLACE FILE ON HOST SERVER
216
RETURN FILING INFORMATION TO SERIAL NUMBER RECONCILIATION MODULE
218
UPDATE TRANSACTION DATABASE
220
UPDATE INDEX
222

FIG. 2

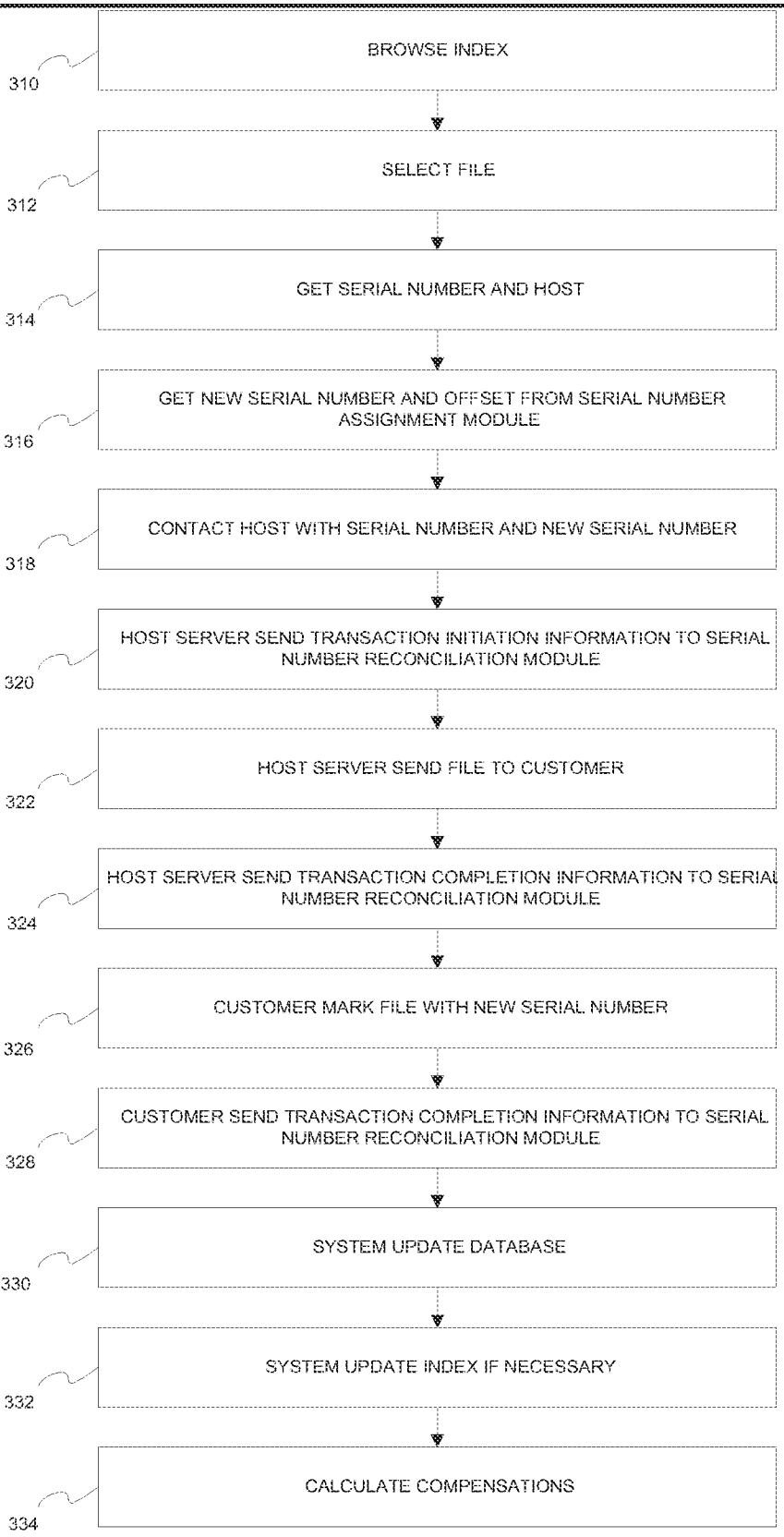
BROWSE INDEX
310
SELECT FILE
312
GET SERIAL NUMBER AND HOST
314
GET NEW SERIAL NUMBER AND OFFSET FROM SERIAL NUMBER ASSIGNMENT MODULE
316
CONTACT HOST WITH SERIAL NUMBER AND NEW SERIAL NUMBER
318
HOST SERVER SEND TRANSACTION INITIATION INFORMATION TO SERIAL NUMBER RECONCILIATION MODULE
320
HOST SERVER SEND FILE TO CUSTOMER
322
HOST SERVER SEND TRANSACTION COMPLETION INFORMATION TO SERIAL NUMBER RECONCILIATION MODULE
324
CUSTOMER MARK FILE WITH NEW SERIAL NUMBER
326
CUSTOMER SEND TRANSACTION COMPLETION INFORMATION TO SERIAL NUMBER RECONCILIATION MODULE
328
SYSTEM UPDATE DATABASE
330
SYSTEM UPDATE INDEX IF NECESSARY
332
CALCULATE COMPENSATIONS
334

FIG. 3

Exhibit 2 - Metadata for Figures dated prior to November 21, 2001

Title:
Subject:
Author: J. Nicholas Gross
Keywords:
Comments:
Creation Date: [redacted]/2001 10:51:00 AM
Change Number: 1
Last Saved On: [redacted] 10:52:00 AM
Last Saved By: J. Nicholas Gross
Total Editing Time: 1 Minute
Last Printed On: 7/14/2007 10:04:00 AM
As of Last Complete Printing
Number of Pages: 1 (approx.)
Number of Words: 15 (approx.)
Number of Characters: 89 (approx.)

EXHIBIT 3 - DRAFT OF PROPOSED CLAIMS PRIOR TO NOVEMBER 21, 2001

1. A system for distributing digital assets in a peer-to-peer connectable environment across a network, including between a first peer network device and a second peer network device, the system comprising:

(a) first rights-holder server coupled to the network, said first right-holder server being adapted to introduce a digital asset into the peer-to-peer connectable environment, said digital asset having an associated first set of distribution rules; and

(b) a second host server coupled to the network, said second host server being adapted to store and distribute said digital asset; and

(c) third management server coupled to the network, said second management server being adapted to track transfers of said digital asset over the network and to generate tracking records associated with said transfers;

wherein said transfers over the network involving said digital asset between the first peer network device, the second peer network device and/or the second host server are processed in accordance with said first set of distribution rules.

2. The system of claim 1, wherein the first peer network device can obtain said digital asset from the second peer network device and/or said second host server, and without requiring further authorization from said first rights-holder server.
3. The system of claim 1, wherein a modification is made to said digital asset for each transfer, said modification being used by said third management server for generating said tracking records.
4. The system of claim 3, wherein said modification does not alter user-perceptible content of said digital asset.
5. The system of claim 3, wherein said modification alters an identification label for said digital asset so that each transfer of said digital asset is associated with a unique identification label.
6. The system of claim 1, wherein said second host server is implemented by at least one of the first peer network device or the second peer network device, so that transfers of said digital asset are performed in a peer-to-peer manner across the network.
7. The system of claim 1, wherein said digital asset includes audio, video, picture and/or text based data.
8. The system of claim 1, wherein a second set of distribution rules can be introduced by said first rights-holder server to affect transfers of said digital asset over the network.
9. The system of claim 1, wherein the network includes the Internet.
10. The system of claim 1, wherein said first set of distribution rules includes indexing information, terms of use, and a location of said second host server.
11. The system of claim 1, wherein said digital asset is also encrypted and/or stegnographically processed so as to reduce unauthorized transfers over said network.

12. The system of claim 1, wherein a new instantiation of said digital asset is created for each transfer occurring over the network between peer devices.

13. A system for introducing digital assets into an electronic network distribution system, comprising:

(a) a first computer coupled to the electronic network distribution system; and

(b) a first software routine executing on said first computer, said first software routine being configured to perform at least the following operations:

i) receiving and storing a digital asset on said first computer; and

ii) processing administration information for said digital asset, including an asset identifier and a rights-holder identifier, and associating the same with said digital asset; and

iii) interacting with a digital asset management system to generate a modified version of said digital asset, said modified version of said digital asset being based on said administration information and tracking history information provided by said digital asset management system;

iv) posting said modified version of said digital asset to a location suitable for download by said peer devices from the electronic network distribution system;

wherein said modified version of said digital asset is configured so that a tracking history can be maintained by said digital asset management system of each transfer of separate instantiations of said digital asset between peer devices coupled to the electronic network distribution.

14. The system of claim 13, wherein said administration information also includes terms of use and expiration data for said digital asset.
15. The system of claim 13, wherein said digital asset includes audio, video, picture and/or text based data.
16. The system of claim 13, wherein said first computer is a server coupled to the internet.
17. The system of claim 13, wherein said digital asset management system and/or said peer devices embed tracking information within said modified version of said digital asset during each instantiation of said digital asset.
18. The system of claim 17, wherein said tracking information includes a unique identifier for each transfer of said modified version of said digital asset within the electronic network.
19. The system of claim 13, wherein said first software routine is further configured to provide second administration information for a digital asset such that later

instantiations of said digital asset within the electronic network distribution system are based on said second administration information.

20. The system of claim 13, wherein said first software routine is further configured to receive accounting information from said digital asset management system, including: (a) information concerning the number of instantiations of said digital asset created by transfers within the electronic network distribution system; (b) revenue derived from and/or to be credited for said transfers.

21. A system for exchanging digital assets over a network, comprising:

(a) a first computer coupled to the network, said first computer storing a digital asset which includes both digital content and a first unique identifier associated with a first instantiation of said digital asset; and

(a) a second computer coupled to the network; and

(b) first software routine executing on said first computer and/or said second computer, said first software routine being adapted to coordinate transfer of said digital asset to said second computer;

wherein a second instantiation of said digital asset is created for said transfer to said second computer, said second instantiation including a second unique identifier.

22. The system of claim 21, wherein said first computer and said second computer operate to transfer said digital asset in a peer to peer manner across the Internet.
23. The system of claim 21, wherein after said transfer, a second transfer of said digital asset can occur from either said first computer and/or said second computer, said second transfer further using a third instantiation of said digital asset and a third unique identifier.
24. The system of claim 21, wherein at least said second computer is a portable electronics device, including a personal computer, a personal digital assistant, and/or a telephone.
25. The system of claim 21, wherein said digital content includes an MP3 based audio file.
26. The system of claim 21, wherein said second unique identifier is based on combining information from any one or more of the following: a first id for said first computer, a second id for said second computer, an asset id for said digital asset, a customer id, a randomly generated number and/or a time of said transfer.
27. The system of claim 21, wherein a catalog of available digital assets is maintained at said first computer.
28. The system of claim 21, wherein said first software routine is also configured to execute an authorization routine, said authorization routine being adapted to secure agreement from a user of said second computer to access terms associated with said digital asset.

29. The system of claim 28, wherein said first routine is also configured to execute a setup routine, said setup routine being adapted to set up a transaction account with a digital asset management system separate from said first computer and said second computer, said transaction account including an identifier for a user of said second computer, identifiers for any transfers performed by said user, and billing information associated with said transfers.
30. The system of claim 28, wherein said first computer coordinates said transfer to said second computer in cooperation with a digital asset management system, such that said digital asset management system provides said second unique identifier.
31. The system of claim 30, wherein said first computer provides authorization for said digital asset management system to track all transfers of digital assets from said first computer.
32. The system of claim 31, wherein said first computer also performs hosting functions, and further receives credits from said digital asset management system for all authorized transfers made of digital assets.
33. The system of claim 28, wherein said second computer polls other computers coupled to the network to determine an optimal transfer source for said digital asset.
34. The system of claim 28, wherein said digital content includes content for a newspaper, a book, a magazine, and/or a periodical.
35. The system of claim 28, wherein said second instantiation of said digital asset is created in accordance with distribution rules in place at the time of said transfer, which distribution rules can be different from distribution rules in place at the time of creation of said first instantiation of said digital asset.

36. A system for managing transfers of digital assets over a network, comprising:

(a) a management computer coupled to the network; and

(b) a first software routine executing on said management computer, said first software routine being adapted to prepare a digital asset for transfer over the network in accordance with a set of distribution rules;

wherein a modified version of said digital asset is generated by said first software routine, said modified version including a unique identification number associated with a first instantiation of said modified version of said digital asset;

(c) a second software routine executing on said management computer, said second software routine being adapted to track transfers of said digital asset over the network;

wherein a separate instantiation of said digital asset is created for each transfer occurring over the network.

37. The system of claim 36, wherein said set of distribution rules are provided by a rights-holder management system, and include restrictions on terms of use and time periods of use.
38. The system of claim 37, wherein said set of distribution rules include information on title, author, and identification numbers for said digital asset.
39. The system of claim 36, wherein said unique identification number is embedded into said first instantiation of said modified version of said digital asset using a steganographic process.
40. The system of claim 36, wherein said transfers of said digital asset take place in a peer-to-peer manner over the network in coordination with said management computer and such that a complete tracking history for said digital asset is maintained by the system.
41. The system of claim 40, wherein said second software routine interfaces with a first client system and a second client system connected to the network in a peer to peer relationship, and provides unique identification numbers for each transfer occurring over the network between said first client system and said second client system.
42. The system of claim 36, wherein said first software routine further identifies network accessible locations available for transfers of said digital asset.
43. The system of claim 36, further including an accounting routine for performing accounting functions in connection with said transfers, including crediting of rights holders accounts, crediting of transaction host accounts, and/or debiting of user accounts.
44. The system of claim 36, further including a monitoring routine for performing authentication operations on digital assets stored and/or transferred between client

systems over the network, said authentication operations including a determination of an embedded serial number of a digital asset and an identification of a last authorized transfer of said digital asset.

45. The system of claim 44, wherein adjustments to a user account, including access privileges, are made in accordance with the determinations made by said monitoring routine.
46. The system of claim 36, wherein a subsequent unique identification number used for a second instantiation of said digital asset is derived in part from said unique identification number.
47. The system of claim 46, wherein a tracking history for said digital asset, including all transfers over the network, can be derived from said subsequent unique identification number.
48. The system of claim 36, wherein at least some portions of said modified version of said digital asset are encrypted and/or subjected to a steganographic process.
49. The system of claim 36, wherein distributions of said digital asset over said network are not preconditioned on securing authorization for individual copies of said digital asset.
50. The system of claim 36, wherein electronic indexes and catalogs are provided by the management computer for facilitating locating and transferring of said digital asset.

EXHIBIT 4 - METADATA FOR CLAIMS FILE PRIOR TO NOVEMBER 21, 2001

Author: J. Nicholas Gross
Keywords:
Comments:
Creation Date: [redacted]2001 9:59:00 AM
Change Number: 7
Last Saved On: [redacted]/2001 4:28:00 PM
Last Saved By: J. Nicholas Gross
Total Editing Time: 371 Minutes
Last Printed On: 7/14/2007 11:17:00 AM
As of Last Complete Printing
Number of Pages: 1 (approx.)
Number of Words: 2,095
Number of Characters: 11,330

Exhibit 5

Subj:Patent App 1st Draft
Date:11/2/2001 2:32:15 PM Pacific Standard Time
From:bdunkeld@earthlink.net
To:nicdagreek@aol.com
CC:emlambert@home.com, bdunkeld@earthlink.net
File:KopeshPatentApp1stDraft.doc (144384 bytes) DL Time (TCP/IP): < 1 minute
Sent from the Internet (Details)

[redacted]

[redacted]

I would like to sit down with you to understand what we should do with it next. Are you available early next week? (any time Monday would be preferable).

Enjoy your weekend,
Bryan

EXHIBIT 6

Subj:Fwd: 2nd draft
Date:11/19/2001 10:27:55 AM Pacific Standard Time
From:bdunkeld@earthlink.net
To:nicdagreek@aol.com
Sent from the Internet (Details)

>Date: Thu, 08 Nov 2001 23:25:05 -0800
>To: nick, ed, b
>From: Bryan Dunkeld <bdunkeld@earthlink.net>
>Subject: 2nd draft
>

[redacted]

>

>Thanks for your very insightful comments,
>Bryan

EXHIBIT 7

Subj:Re: latest claims etc
Date:12/4/2001 10:47:00 AM Pacific Standard Time
From:bdunkeld@earthlink.net
To:NicdaGreek@aol.com
CC:emlambert@attbi.com
Sent from the Internet (Details)

Great,

Full names and addresses:

Bryan C. Dunkeld

63 Liberty Dock

Sausalito, CA 94965

Edward M. Lambert

3011 68th Avenue SE

Mercer Island, WA 98040

(the C is for Charles and the M is for Moore but we both prefer just middle initials)

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

Best,

Bryan

At 02:23 AM 12/4/01 EST, you wrote:

>>>>

<excerpt><fontfamily><param>Garamond</param>Hi Bryan,

[redacted]

[redacted]

My hope is to finish it tomorrow or Wednesday, and thus give you a day to make final changes. Anthony will prepare the PTO paperwork Thursday, and if you sign it on Friday we can file it on Monday. Please let us have your full names and real addresses for the formal paperwork.

Talk to you soon,

NICK </fontfamily><fontfamily><param>arial</param>

</fontfamily></excerpt><fontfamily><param>arial</param><<<<<<<<

</fontfamily>

[redacted]